

REMARKS

Status of the Claims

Claims 1-6, 8-25, and 27-34 remain pending in the application, Claims 7, 26, and 35 - 38 having been previously canceled, Claim 14 having been amended above to include a step generally similar to step (d) of Claim 29, and Claim 25 having been amended to correct a typographical error.

Claims Rejected Under Provisional Obviousness-Type Double Patenting

Claims 1-6, 8-25, and 27-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 39-54 of the copending U.S. Patent Application Serial No. 11/090,826. The Office Action indicates that although the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitations of Claims 1-6, 8-25, and 27-34 of the above-identified application are found in Claims 39-54 of U.S. Patent Application Serial No. 11/090,826. In addition, the Office Action indicates that Claims 1-6, 8-25, and 27-34 are anticipated by Claims 39-54 of U.S. Patent Application No. 11/090,826, because all the limitation of broader genus claims of the above-identified application are contained in the narrower species claims of U.S. Patent Application Serial No. 11/090,826, as enunciated in *Eli Lilly & Co. v. Barr Laboratories, Inc.*, 58 USPQ2d 1869 (CA FC 2001).

Applicants respectfully disagree with the Examiner's provisional rejection of Obviousness-Type Double Patenting because independent Claims 1, 14, 29, and 33 of the above-identified application include claim recitations that are not found in independent Claims 39, 45 and 50 of U.S. Patent Application Serial No. 11/090,826, and there is no reason why these recitations would have been obvious to a person of ordinary skill in the art, in view of the claim language in the other application. Thus, Claims 1-6, 8-25, and 27-34 of the above-identified application are not obvious in view of Claims 39-54 of U.S. Patent Application Serial No. 11/090,826.

Independent Claim 1

Independent Claim 1 includes recitation regarding an automatic invitation and an availability status. More specifically, Claim 1 of the present application recites:

(b) enabling the host player to select one or more of the other persons from among the list of contacts to participate in playing the multiplayer online electronic game;

(c) automatically sending an electronic invitation to each of the one or more other persons selected by the host player, to join in playing the multiplayer online electronic game;

Once the host player has selected one or more of the other persons, as recited in step (c), *an invitation is automatically sent out*. This step is not recited in independent Claims 39, 45, or 50 of U.S. Patent Application No. 11/090,826 and would not have been obvious in view of the recitation in those claims. Furthermore, Claim 1 of the present application also recites:

(e) providing an availability status for each person in the list of contacts so as to enable the host player to identify persons in the list of contacts who are currently available for playing the multiplayer online electronic game.

The recitation of an availability status is not recited in independent Claims 39, 45, or 50 of U.S. Patent Application No. 11/090,826 and there is no reason that it would have been obvious in view of the claims in this other application.

Independent Claims 14 and 29

Independent Claims 14 and 29 of the present application recite enabling the host player to forward a network address. More specifically, independent Claim 14 recites the step of:

(d) enabling the host player to forward a network address corresponding to an electronic device being operated by the host to any other player participating in the chat session;

Independent Claim 29 recites the step of:

(d) enabling the host player to forward a network address corresponding to an electronic device being operated by the host to any other player participating in the voice chat session;

However, this step is not recited in independent Claims 39, 45, or 50 of U.S. Patent Application No. 11/090,826, and one of ordinary skill in the art would not find it obvious in view of the claims in this other application.

Independent Claim 33

Independent Claim 33 recites producing an audible announcement, specifically:

(e)(vii) producing an audible announcement with said at least one sound transducer apprising a recipient of the electronic invitation that the host player has invited the recipient to join the chat session

1 No equivalent recitation is provided in independent Claims 39, 45, or 50 of U.S. Patent
2 Application No. 11/090,826, and the recitation would not have been obvious to one of ordinary skill
3 in the art in view of the claims in the other application.

4 Accordingly, for the reasons set forth above that illustrate how independent Claims 39, 45,
5 and 50 of U.S. Patent Application No. 11/090,826 lack the claim recitations of independent Claims 1,
6 14, 29 and 33, and the recitation would not be considered obvious in view of the claims in the other
7 application, applicants respectfully request that the Examiner withdraw the Provisional
8 Obviousness-Type Double Patenting rejection.

9 Claims Rejected under 35 U.S.C. § 103(a)

10 The Examiner has rejected Claims 1-6, 8-25, and 27-34 under 35 U.S.C. § 103(a) as being
11 unpatentable over Kaji et al. (U.S. Patent No. 6,183,367, hereinafter referred to as “Kaji”) in view of
12 Appelman et al. (U.S. Patent No. 6,677,968, hereinafter referred to as “Appelman”), and further in view
13 of Das et al. (ACM Publication VRST’ 97 “NetEffect: A Network Architecture for Large-scale Multi-user
14 Virtual Worlds,” hereinafter referred to as “Das”).

15 Claims 2, 4, 8, 10-11, 13, 15-16, 21, 24-25, 27-28, 30, 32, 34-35 are rejected over the art as
16 applied as above in rejecting Claims 1, 14, 29, and 33. Furthermore, the Examiner asserts that Kaji and
17 Appelman teach and describe a system and method of computer games that is played over the computer
18 network. However, note that Claim 35 was previously canceled and that its rejection is therefore moot.

19 Claims 3, 5-7, 9, 12, 17-19, 22, 26, 31 and 36 are rejected over the art as applied above in
20 rejecting Claims 2, 4, 8, 11, 16, 21, 25, 30, and 35. Furthermore, the Examiner asserts that Kaji and
21 Appelman describe a system and method of on-line messaging that facilitates users selecting participants.
22 However, applicants note that Claim 36 was also previously cancelled, so its rejection is moot.

23 Claims 20 and 23 are rejected over the art as applied above in rejecting Claims 19 and 22.
24 Furthermore, the Examiner asserts that Kaji and Appelman teach and describe an on-line game playing
25 mechanism. Applicants respectfully disagree with this rejection and preceding rejections for the reasons
26 set forth below.

27 In the interest of reducing the complexity of the issues for the Examiner to consider in this
28 response, the following discussion focuses on independent Claims 1, 14, 29, and 33. The patentability of
29 each remaining dependent claim is not necessarily separately addressed in detail. However, applicants’
30 decision not to discuss the differences between the cited art and each dependent claim should not be

1 considered as an admission that applicants concur with the Examiner's conclusion that these dependent
2 claims are not patentable over the disclosure in the cited references. Similarly, applicants' decision not to
3 discuss differences between the prior art and every claim element, or every comment made by the
4 Examiner, should not be considered as an admission that applicants concur with the Examiner's
5 interpretation and assertions regarding those claims. Indeed, applicants believe that all of the dependent
6 claims patentably distinguish over the references cited. Moreover, a specific traverse of the rejection of
7 each dependent claim is not required, since dependent claims are patentable for at least the same reasons
8 as the independent claims from which the dependent claims ultimately depend.

9 Discussion of the Patentability of Independent Claim 1

10 Significant differences exist between the recitation of independent Claim 1 and the cited art
11 because the cited art does NOT teach or suggest all of the recited details of this claim, i.e.,
12 specifically, the cited art does NOT teach or suggest *automatically* sending an electronic invitation to
13 each of the one or more other persons and does not teach or suggest sending an invitation to anyone
14 selected by a *host player*.

15 Automatic Sending of an Electronic Invitation

16 It might be helpful to give examples of some of the steps of applicants' independent Claim 1
17 in order to clearly illustrate the functionality of the recited steps. In their entirety, applicants' steps
18 (b) and (c) of Claim 1 recite, respectively:

19 (b) enabling the *host player* to select one or more of the other persons
20 from among the list of contacts to participate in playing the multiplayer online
electronic game;

21 (c) *automatically* sending an electronic invitation to each of the one or
22 more other persons selected by the *host player*, to join in playing the multiplayer
online electronic game;

23
24 For example, if a host player (e.g., Adam) would like to host a chat session to initially include
Burt 57, Don 58, and Chuck 64 as shown in FIGURE 8, Adam can "(a) double click on each contact
he would like to invite to the chat session; (b) drag the desired contacts onto chat pane 72, such as
shown in the Figure; or (c) select one or more contacts, activate chat pane 44's context menu, and
selecting an appropriate option to invite the contact or contacts" (see applicants' specification, page 13,
lines 11-15). Thus, applicants illustrate enabling the host player (e.g., Adam) to select one or more of
the other persons (e.g., Burt, Don or Chuck) from among the list of contacts.
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1 In addition, FIGURE 8's accompanying disclosure explains that if the invited contact's
2 messenger status is "online," and the invited contact is running an instance of the gaming utility, the
3 contact will receive an invitation message, causing a modal dialog to appear on the contact's screen
4 (see applicants' specification, page 13, lines 27-30). In other words, once Adam (i.e., the host player)
5 selects Burt or Don or Chuck, an invitation is *automatically* sent out. Thus, applicants illustrate
6 automatically sending an electronic invitation to each of the one or more other persons selected by
7 the host player.

8 In contrast, neither Kaji nor Appelman teaches or suggests automatically sending an
9 electronic invitation to each of the one or more other persons selected by a player. In response to
10 applicants' previous argument in the response to the Office Action Response dated
11 February 09, 2006, that Kaji does not teach the equivalent of applicants' "host player," the Examiner
12 indicates that he does not find this argument persuasive. The Examiner asserts that the cited prior art
13 teaches a system and method for a multiplayer networked gaming environment where the game
14 communication system connects the game devices through a communication medium, thereby
15 forming the network. This gaming host system also teaches that each game apparatus is controlled by
16 a player when executing the game. Therefore, the host gaming system teaches a home player (which
17 the Examiner asserts is equivalent to a host player, where the players are located in the same virtual
18 space) who transfers game data, which involves the transmission and reception of game data required
19 by the host system of the home game device, between the home device and other game devices. In
20 support of his assertion, the Examiner cites column 22, lines 27-43 and column 23, lines 44-63 of
21 Kaji. Applicants strongly disagree that a home player is equivalent to a host player as discussed in
22 applicants' specification and as recited in applicants' claims. However, assuming *arguendo*, that the
23 "home player" of Kaji is equivalent to the "host player" as recited in the claims of the present
24 application, applicants can find no teaching that Kaji's (home) player automatically sends an
25 electronic invitation to each of the one or more other persons selected by a *host player* (or by the
26 home player).

27 Kaji discusses how there is a circuit that relates to a composition for synthesizing noise and
28 sound effects with the voice of the (home) player (Kaji, column 22, lines 27-29), and how the block
29 composition processes the voice of the (home) player and transmits it to the other devices
30 (opponents) (Kaji, column 22, line 61-column 23, line 1). However, Kaji does not teach or suggest

1 that the (home) player is enabled to select one or more of the other persons from among the list of
2 contacts to participate in playing the multiplayer online electronic game, and as a result of this
3 selection by the home player, automatically sends an electronic invitation to each of the one or more
4 other persons selected by the home player, to join in playing the multiplayer online electronic game.
5 Accordingly, the art cited does not teach what is recited in applicants' claims.

6 Lack of Motivation to Combine References

7 As discussed in the previous Office Action response, applicants respectfully maintain that
8 there is no motivation to combine the cited art because Appelman is directed to a notification system
9 for each user who is logged onto a system. Appelman does not teach or suggest any kind of gaming
10 system and therefore would not be included in art that a person of ordinary skill would even consult if
11 trying to produce what applicants have recited in their claims. In addition, it appears that the Examiner
12 relies upon Appleman for disclosing creating a list of contacts (Office Action, page 3) as recited in
13 applicants' step (a), but is apparent that that this reference and none of the other references teach
14 applicants' steps (b) and (c). For example, Appleman does not teach automatically sending out
15 invitations. Appelman discloses that FIGURE 10 shows a BUDDY CHAT window 110 and explains
16 how the Buddy Chat function can be used to *manually* send an invitation to one or more co-users
17 (Appelman, column 6, lines 40-44). However, Appelman then discloses how once a co-user's name
18 is selected, the user activates the BUDDY chat button to send a message to each invitee via the
19 Message to Send field (Appelman, column 6, lines 49-53). Thus, because these multiple steps in
20 Appelman require the user to manually initiate sending messages and there is no teaching or
21 suggestion of automatically sending an invitation (or any other type of message), it is evident that
22 invitations to participate in playing a game are not sent *automatically* in Appelman.

23 Thus, Claim 1 distinguishes over Kaji in view of Appelman. Accordingly, the rejection of
24 independent Claim 1 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of
25 Das should be withdrawn. Because dependent claims inherently include all of the recitation of the
26 independent claims from which the dependent claims ultimately depend, and because the combined cited
27 references do not disclose or suggest all of the elements of independent Claim 1, the rejection of
28 dependent Claims 2-6 and 8-13 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in
29 view of Das should be withdrawn for at least the same reasons as the rejection of Claim 1.

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1 Patentability of Independent Claim 14

2 Significant differences exist between the recitation of independent Claim 14 and the cited art
3 because the cited art does NOT teach or suggest a host player and does not teach or suggest
4 automatically launching an instance of the multiplayer online electronic game on each electronic
5 device being operated by any player participating in the chat session. In its entirety, applicants' step
6 (d) of Claim 14 recites:

7 *automatically launching an instance of the multiplayer online electronic game on each*
8 *electronic device being operated by any player participating in the chat session*, said
9 step of automatically launching being **in response to a game initiating action**
10 **performed by the host player** so that any player participating in the chat session
automatically becomes a participant in the multiplayer online electronic game.

11 For example, applicants' FIGURE 19 illustrates how the host player is enabled from user
12 interface frame 32 to activate "Chat Options," activate a control 74, and select a "Start a Game"
13 option 160. The host player is then enabled to select one of a plurality of DIRECTPLAY™ Lobby
14 Games 164, which is one example of a game initiating action performed by the host player that
15 causes the recited details of Claim 14 to be automatically carried out. The accompanying disclosure
16 in applicants' specification further explains:

17 With reference to FIGURE 19, when all of the players the host desires to have
18 participate in a multiplayer online computer game have joined the host in the chat
19 session, the host can launch an instance of a DIRECTPLAY™ Lobby Game on each of
20 the chat session participants' computers by activating "Chat Options" control 74, and
selecting a "Start a Game" option 160. This will cause a cascaded game selection
21 menu 162 to be displayed, enabling the host to select one of a plurality of
DIRECTPLAY™ Lobby Games 164 listed in an upper portion of a the menu,
whereupon the selected DIRECTPLAY™ Lobby Game will be automatically launched
22 on all of the chat participants' computers that have the DIRECTPLAY™ Lobby Game
installed. (See applicants' specification, page 23, lines 13-22.)

24 In response to the host player's game initiating action, applicants' specification teaches that
25 the game is *automatically launched on all of the chat participants' computers* that have the game
26 installed. Thus, all of the chat participants automatically became participants in the game, which is
27 one example of automatically launching an instance of the multiplayer online electronic game on
28 each electronic device being operated by any player participating in the chat session. The step of
29 *automatically* launching is in response to a game initiating action performed by the host player so
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1 that any player participating in the chat session *automatically* becomes a participant in the
2 multiplayer online electronic game.

3 In contrast, the cited art does NOT teach or suggest automatically launching an instance of the
4 multiplayer online electronic game in response to a host player action. Instead, Kaji teaches that *each*
5 *player* manually executes the game. The Examiner asserts that the cited art teaches the above step as
6 recited by applicants' claim, and in support of his assertion, the Examiner cites FIGURE 9 and
7 column 8, line 55-column 9, line 41 and column 10, line 20 to column 11, line 30 of Kaji. However,
8 Kaji teaches "Each host system 32 is a system whereby the *respective players execute the game* (Kaji,
9 column 8, lines 66-67). Thus, Kaji does not teach or suggest that an instance of the game is
10 *automatically launched* in response to an action performed by the host player, but instead, a game is
11 manually launched by each player wishing to participate.

12 As discussed in the previous Office Action response, applicants respectfully maintain that
13 there is no motivation to combine the cited art because Appelman is directed to a notification system
14 for each user who is logged onto a chat system. Appelman does not teach or suggest any kind of gaming
15 system. Claim 14 clearly distinguishes over Kaji in view of Appelman, because the combination of Kaji,
16 Appelman, and Das, does not teach or suggest a host player, and does not suggest automatically launching
17 an instance of a game in response to an action by a host player. Accordingly, the rejection of independent
18 Claim 14 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be
19 withdrawn. Because dependent claims inherently include all of the recitation of the independent claims
20 from which the dependent claims ultimately depend, and because Kaji, in view of Appelman, and further
21 in view of Das does not disclose or suggest all of the elements of independent Claim 14, the rejection of
22 dependent Claims 15-25 and 27-28 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further
23 in view of Das should be withdrawn.

24 Patentability of Independent Claim 29

25 Significant differences exist between the recitation of independent Claim 29 and the cited art
26 because the cited art does NOT teach or suggest a host player and selectively launching an instance of
27 the game, if a game selected by the host that the host will be launching or has already launched has
28 been identified in a voice chat message.

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1 Step (e) of independent Claim 29 recites:

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3 transmitting a voice chat message from the host player to any other player
4 participating in the voice chat session, said voice chat message identifying a multiplayer
5 online electronic game that the host player will be launching or has already launched on
6 the electronic device operated by the host player so that any other player participating in
7 the voice chat session can selectively launch an instance of the multiplayer online
8 electronic game on the electronic device operated by the player, so that any player
9 participating in the chat session who selectively launches the multiplayer online
10 electronic game becomes a participant in the multiplayer online electronic game.

11 Applicants' specification discloses:

12 There will be instances where the game participants will want to play a
13 multiplayer online computer game that is not a DIRECTPLAY™ Lobby Game. In
14 these instances, the players in the chat session will have to agree upon a game to play
(or be informed by the host of a game selected by the host that the host will be launching
or has already launched), and each player will have to manually start an instance of the
15 agreed-upon or host-selected game. (Emphasis added, applicants' specification,
16 page 23, lines 29-34).

17 More specifically, once players are informed of the host launching a game or are informed
18 that the host will launch a game, players who are in the chat session can manually start an instance of
the game, or in other words, selectively launch the game and thereby become participants in the
game.

19 In contrast, Kaji does NOT teach or suggest this step because Kaji teaches a host system, not a
20 host player. In support of his rejection of Claim 29, the Examiner asserts that Kaji discloses this step
21 (i.e., step (e) of applicants' claim) in Figure 9, column 8, line 55 to column 9, line 41, and at
22 column 10, line 20 through column 11, line 30. However, Kaji teaches a host system 32 whereby the
23 respective players execute the game as disclosed in column 8, lines 66-67. There is no indication that
24 if a voice chat message identifies a game that the *host player* will launch or has already launched, that
25 other players selectively launch the game that the host player launched.

26 As discussed in the previous Office Action response, applicants respectfully maintain that
27 there is no motivation to combine the cited art because Appelman is directed to a notification system
28 for each user who is logged onto a system. Appelman does not teach or suggest any kind of gaming
29 system. Claim 29 distinguishes over Kaji, in view of Appelman, and further in view of Das because the
30 cited art does not teach or suggest a host player and does not teach or suggest selectively launching an

1 instance of the game if a game selected by the host that the host will be launching or has already
2 launched has been identified in the voice chat message. Accordingly, the rejection of independent
3 Claim 29 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of Das should be
4 withdrawn. Because dependent claims inherently include all of the recitation of the independent claims
5 from which the dependent claims ultimately depend, and because Kaji, in view of Appelman, and further
6 in view of Das does not disclose or suggest all of the recitation of independent Claim 29, the rejection of
7 dependent Claims 30-32 under 35 U.S.C. § 103(a) over Kaji, in view of Appelman, and further in view of
8 Das should be withdrawn.

9 Patentability of Independent Claim 33

10 Independent Claim 33 is directed towards a system for enabling a host player to select one or
11 more other players to participate in playing a multiplayer online electronic game played using a plurality
12 of electronic devices linked in communication over a communications network. The Examiner has
13 rejected this claim for reasons similar to Claim 1 and in addition to the citations provided to support the
14 rejection of Claim 1 and of the other independent Claims, cites column 22, lines 25-63 of Kaji. Step
15 (e)(iv) of Claim 33 is generally similar to step (d) of Claim 14. Thus, for the same reasons noted above in
16 traversing the rejection of Claim 14 (as discussed in detail in the response to the previous Office
17 Action), applicants respectfully maintain that there is no motivation to combine the cited art because
18 Appelman is directed to a notification system for each user who is logged onto a system. Appelman does
19 not teach or suggest any kind of gaming system. As outlined above in the traversal of the rejection of
20 Claim 14, the cited art does not teach or suggest a host player and automatically launching an
21 instance of the multiplayer online electronic game on each electronic device being operated by any
22 player participating in the chat session. Thus, Claim 33 also distinguishes over the cited art.

23 Accordingly, the rejection of independent Claim 33 under 35 U.S.C. § 103(a) over Kaji, in view
24 of Appelman and further in view of Das should be withdrawn. Because dependent claims inherently
25 include all of the elements of the independent claims from which the dependent claims ultimately depend.
26 Because Kaji, in view of Appelman does not disclose or suggest all of the recitation of independent
27 Claim 33, the rejection of dependent Claim 34 under 35 U.S.C. § 103(a) over this combination of
28 references should be withdrawn.

29 In view of the Remarks set forth above, it will be apparent that the claims remaining in this
30 application define a novel and non-obvious invention, and that the application is in condition for

1 allowance and should be passed to issue without further delay. Should any further questions remain, the
2 Examiner is invited to telephone applicants' attorney at the number listed below.

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4 Respectfully submitted,
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7 /sabrina k. macintyre/
8 Sabrina K. MacIntyre
Registration No. 56,912

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